Application No.: 09/893,301   **Atty Docket: INXT 1017-1**

REMARKS

Claims 1-10 are currently pending in this application and have been rejected by the Examiner under 35 U.S.C. 102(e) as being anticipated by Castelli et al. (U.S. Patent 6,122,628, hereafter "Castelli").

Rejection Under 35 U.S.C. 6 102(e) of Claims 1-10

The Examiner maintains his rejection of claims 1-10 under 35 U.S.C. § 102(e) as anticipated by Castelli et al., U.S. Pat. No. 6,122,628.

For the Examiner's reference, the first three paragraphs of this section repeat our prior analysis, that claims 1-10 are methods operating on "a k nearest neighbor database, said database including original documents, categories, category assignments for the original documents, and category scores for the original documents". This is not the kind of database used by Castelli; there is no list to retain of at least k nearest neighbors and corresponding similarity scores. The Examiner offers no point citation suggesting to the contrary. Therefore, claims 1-10 should be allowable over Castelli.

Castelli avoids building a k nearest neighbor database with lists of nearest neighbors, preferring instead to apply cluster analysis. Castelli describes how the clustering can be used to answer k nearest neighbor queries by creating ad hoc nearest neighbor sets, but that is a way of avoiding building a k nearest neighbor database with lists of nearest neighbors. In Castelli's teaching, k is a query parameter for ad hoc queries, not a list length for nearest neighbor lists. One of skill in the art will recognize that clustering is diametrically opposed to category assignment, which can be carried out or double checked by an editor, as clustering is purely mathematical and ultimately abstract; it requires much insight (and sometimes guile) to assign concrete meaning to a cluster dimension.

Of course, having chosen an alternative to using a k nearest neighbor database, Castelli has nothing to teach about incrementally "updating precision and recall curves", "adding category assignments", or incrementally performing any other maintenance of a k nearest neighbors database, including lists of nearest neighbors.

In response to the argument restated above, the Examiner declined to give given any patentable weight to the structure in the preamble, "a k nearest neighbor database,

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said database including original documents, categories, category assignments for the original documents, and category scores for the original documents". This is at odds with MPEP § 2111.02 at 2100-50 to -51 (Rev. 2, May 2004), which reads, in part (with emphasis added):

PREAMBLE STATEMENTS LIMITING STRUCTURE

Any terminology in the preamble that limits the structure of the claimed invention **must** be treated as a claim limitation. *See, e.g., Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.,* 868 F.2d 1251, 1257, 9 USPQ2d 1962, 1966 (Fed. Cir. 1989) ... *See also In re Stencel,* 828 F.2d 751, 4 USPQ2d 1071 (Fed. Cir. 1987). (The claim at issue was directed to a driver for setting a joint of a threaded collar, however the body of the claim did not directly include the structure of the collar as part of the claimed article. The examiner did not consider the preamble, which did set forth the structure of the collar, as limiting the claim. The court found that the collar structure could not be ignored. While the claim was not directly limited to the collar, the collar structure recited in the preamble did limit the structure of the driver. "[T]he framework - the teachings of the prior art - against which patentability is measured is not all drivers broadly, but drivers suitable for use in combination with this collar, for the claims are so limited." *Id.* at 1073, 828 F.2d at 754.).

The Examiner's argument applies to the preambles of some claims, to preambles that merely recite the purpose of a process or an intended use of an invention. But the MPEP instructs the Examiner to proceed with a "determination of whether [the] preamble limits a claim ... on a case-by-case basis in light of the facts in each case; there is no litmus test defining when a preamble limits the scope of a claim." *Id.* The section of the MPEP discussing statements in a preamble providing structure and treated as a claim limitation to distinguish prior art appears in the MPEP before the section on preambles that merely recite an environment. Because the terms relied on recite structure, instead of purpose, the Applicants are entitled to rely on them for patentability and the Examiner "must" give them patentable weight.

In addition, the courts have held that

... Additionally, dependence on a particular disputed preamble phrase for antecedent basis may limit claim scope because it indicates a reliance on both the preamble and claim body to define the claimed invention. *Bell Communications Research, Inc. v. Vitalink Communications Corp.,* 55 F.3d 615, 620, 34 USPQ2d 1816, 1820 (Fed. Cir. 1995) ("When the claim drafter chooses to use both the preamble and the body to define the subject matter

of the claimed invention, the invention so defined, and not some other, is the one the patent protects."). Likewise, when the preamble is essential to understand limitations or terms in the claim body, the preamble limits claim scope. *Pitney Bowes*, 182 F.3d at 1306. ...

... Moreover, clear reliance on the preamble during prosecution to distinguish the claimed invention from the prior art transforms the preamble into a claim limitation because such reliance indicates use of the preamble to define, in part, the claimed invention. See generally Bristol-Myers Squibb Co. v. Ben Venue Labs., Inc., 246 F.3d 1368, 1375, 58 USPQ2d 1508, 1513 (Fed. Cir. 2001) (A preamble may limit when employed to distinguish a new use of a prior art apparatus or process.). Without such reliance, however, a preamble generally is not limiting when the claim body describes a structurally complete invention such that deletion of the preamble phrase does not affect the structure or steps of the claimed invention. IMS Tech., Inc. v. Haas Automation, Inc., 206 F.3d 1422, 1434, 54 USPQ2d 1129, 1136-37 (Fed. Cir. 2000) (preamble phrase "control apparatus" does not limit claim scope where it merely gives a name to the structurally complete invention).

Catalina Marketing *International, Inc. v. Coolsavings.Com, Inc.*, 289 F.3d 801, 808-809 (Fed. Cir. 2002) *cited in* MPEP § 2111.02 at 2100-50. The Examiner has not considered whether there has been binding reliance during prosecution and has not considered whether Applicants relied on the preamble to define the claimed subject matter.

These Applicants relied on the preamble in their response of 28 February 2005. Unless the Examiner says that those prosecution statements have no weight and should not be relied upon for any purpose, competitors and courts court will consider the preamble to limit the claim and so should this Examiner.

In drafting, Applicants could be considered to have relied on the preamble to define the claimed invention, which incrementally updates a database, including the step of "retaining" certain data that is created in the process of creating such a database. One cannot ignore the database and still "retain" a list of m nearest neighbors in a k nearest neighbor database, "wherein m>k". The expression "m>k" only has meaning in the context of the preamble, which refers to a k nearest neighbors database. Retaining information without claiming the step of creating the information implies the existence of a database.

For three distinct reasons, Applicants believe that the Examiner is bound by law and the MPEP to give patentable weight to the preamble.

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However, if the Examiner decides the Applicants are wrong, does not give patentable weight to the preamble, rejects reliance on the preamble and concludes that Applicants' statements are not binding for later interpretation, the **non-preamble** limitations of the claims still support the distinctions over Castelli that were previously asserted. First, the retaining step describes a k nearest neighbor database with lists of nearest neighbors, which distinguishes over applying cluster analysis. Second, the retaining step specifies the length of the nearest neighbor list as m>k, which is a basis for distinguishing over Castelli's teaching of k as a query parameter for ad hoc queries. Third, the updating, adding and similar steps claim incrementally "updating precision and recall curves", "adding category assignments", or incrementally performing any other maintenance of a k nearest neighbors database, including lists of nearest neighbors. This distinguishes over Castelli, which teaches nothing about maintaining such elements of a database. These non-preamble limitations were specifically mentioned in the prior response and not taken into account in the final office action.
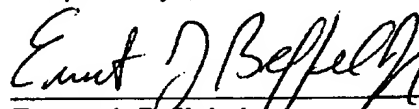
With this response, Applicants are submitting a notice of appeal, to be pursued if the Examiner does not reconsider the final rejection.

CONCLUSION

Applicants respectfully submit that the pending claims are now in condition for allowance and thereby solicit acceptance of the claims, in light of these amendments.

The undersigned can ordinarily be reached at his office at (650) 712-0340 from 8:30 a.m. to 5:30 p.m. PST, Monday through Friday, and can be reached at his cell phone at (415) 902-6112 most other times.

Respectfully submitted,

Dated: 24 August 2005

Ernest J. Beffel, Jr.
Registration. No. 43,489

HAYNES BEFFEL & WOLFELD LLP
P.O. Box 366
Half Moon Bay, CA 94019
Telephone: (650) 712-0340
Facsimile: (650) 712-0263